

POCKET NO: 255880US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

MARKUS SCHERER, ET AL.

: EXAMINER: BERNSHTEYN

SERIAL NO: 10/505,370 :

FILED: AUGUST 23, 2004

: GROUP ART UNIT: 1713

FOR: COPOLYMERS AS DEWAXING  
ADDITIVES :

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

Responsive to the Official Action dated May 18, 2007, Applicants elect, with traverse,  
Group I, Claims 2-8, 11-13, 21; 22, 28 and 30.

REMARKS

The Office has required restriction in the present application as follows:

Group I: Claims 2-8, 11-13, 21, 22, 28 and 30, drawn to a dewaxing additive; and

Group II: Claims 14, 15, 23-27 and 29, drawn to a method for solvent deparaffinization.

Applicants elect, with traverse, Group I, Claims 2-8, 11-13, 21, 22, 28 and 30.

The Restriction requirement is believed to be unsustainable because all claims were previously examined as evidenced by the Office Action of October 10, 2006. In the amendment filed February 12, 2007, Claims 11 and 14 were simply rewritten in independent form. Thus, the Examiner cannot now refuse to further examine all of the claims.

Applicants traverse that Restriction Requirement on the additional ground that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority. The Authority did not take the position that unity of invention was lacking in the International application and examined all claims together. Applicants note that PCT Article 27(1) states that no national law shall require compliance with requirements relating to the form and contents of the International application different from or additional to those which are provided for in the Patent Cooperation Treaty and the Regulations.

A copy of the International Search Report is attached herewith.

Moreover, the MPEP in §803 states as follows:

"If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact, the International Searching Authority has searched all of the claims together.

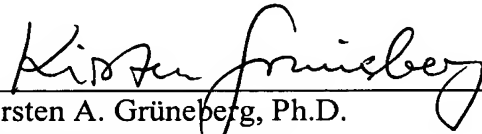
Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Application No. 10/505,370  
Reply to Office Action of May 18, 2007

Applicants respectfully submit that the above-identified application is now in  
condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Norman F. Oblon

A handwritten signature in cursive script, reading "Kirsten A. Grüneberg", written over a horizontal line.

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